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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,608	02/14/2001	Milton Smith	0879-0299P	9767

2292 7590 08/22/2005

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EXAMINER

BAYERL, RAYMOND J

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 08/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/782,608

**Applicant(s)**

SMITH, MILTON

**Examiner**

Raymond J. Bayerl

**Art Unit**

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1 - 9, 11 - 12, 15 - 38, 40 - 47 is/are allowed.
- 6) ☒ Claim(s) 10, 13 - 14, 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

Art Unit: 2173

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 10, 39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites "The one or more computer-readable media of claim 9", when claim 9 is instead a "computer-implemented method". The Examiner had intended to refer to claim 10, rather than claim 9, as having this difficulty in the previous office action mailed 4 April 2005, and regrets any inconvenience this may have caused applicant.

The newly-amended claim 24 recites: "sending the one or more images and the text order file to a remote second processing device" (lines 6 – 7), which makes dependent claim 39 unclear, since it continues to recite that "the kiosk further comprises the second processing device".

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 13 – 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

In taking the present application up for further review, the Examiner noted that claim 13 is directed to "A computer-readable medium having embodied thereon a computer program for processing by a computer", where applicant notes in the specification at page 32 that "The functionality that represents the GLS 100...could be loaded into a hardware suite as an article of manufacture or as a propagated [sic]

signal.” Thus, claim 13 can be interpreted to be a propagated signal, which does not meet the statutory requirements. Claim 14 actually goes on to limit the claimed invention in this manner—to a “propagated signal”.

The question to be answered in considering such a claim in view of 35 USC 101 is whether the claim is directed to something that affords a practical application that provides a useful, concrete and tangible result. Case law to date will support that software is statutory when stored on computer readable media which, when executed by a computer, provides a useful, concrete and tangible result. Lacking in this case law are indications of how to handle claimed instructions that are carried by signals and waves. Absent recitation of some piece of hardware to receive and process a signal, the PTO does not currently accept that the mere recitation of the instructions being carried by a signal or a wave provide the instructions in a manner that enables their functionality to be realized. As such, they are believed to be non-statutory.


5. Claims 1 – 47 are deemed to be allowable over the prior art of record, in view of applicant’s 1 July 2005 amendment and response. The response previous to this was persuasive in establishing the patentability of claims 1 – 23, 41 – 47, and applicant’s amendment and remarks concerning independent claim 24 is sufficient, in particular, to overcome the 35 USC 103 rejection of claims 24 – 40 as being unpatentable over the combination of Frey et al. (US #6,369,908 B1) in view of Yager et al. (US #5,983,236). The extent of direction given the “images” and “text order file”, i.e., to “a unique directory” corresponding to “a unique order identifier” is not seen in Frey et al.’s distribution of such content in a KIOSK.

Art Unit: 2173

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raymond J. Bayerl whose telephone number is (571) 272-4045. The examiner can normally be reached on M - Th from 9:00 AM to 4:00 PM ET.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (571) 272-4048. All patent application related correspondence transmitted by FAX **must be directed** to the central FAX number (571) 273-8300.

8. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-2100.



RAYMOND J. BAYERL  
PRIMARY EXAMINER  
ART UNIT 2173

15 August 2005